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SUE Z. SHAPER, P.C.  
1800 WEST LOOP SOUTH  
SUITE 1450  
HOUSTON, TX 77027

EXAMINER

MORRISON, JAY A

ART UNIT PAPER NUMBER

2168

DATE MAILED: 07/26/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

10/776,069

Applicant(s)

SANDERS ET AL.

Examiner

Jay A. Morrison

Art Unit

2168

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 11 February 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-36 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-36 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 11 February 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                        | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)               | Paper No(s)/Mail Date. _____  |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date <u>2/11/04</u> .   | 6) <input type="checkbox"/> Other: _____                                    |

### **DETAILED ACTION**

1. Claims 1-36 are pending.

#### ***Claim Rejections - 35 USC § 112***

2. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 1 and 22 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The limitation imposing a "business model" is not sufficiently described in the specification.

Claims 2 and 23 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. Including "standards of operation" is not sufficiently described in the specification.

Claims 3 and 27 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. Including "professional management" is not sufficiently described in the specification.

Claims 4 and 28 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. Including "organization and comprehensiveness" is not sufficiently described in the specification.

Claims 21 and 36 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. Including "more than simply geographic" is not sufficiently described in the specification.

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claims 1-4,16-18,22-36 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 1 and 22 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The limitation imposing a "business model" is not sufficiently described in the claim or specification.

Claims 2 and 23 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Including "standards of operation" is not sufficiently described in the claim or specification.

Claims 3 and 27 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Including "professional management" is not sufficiently described in the claim or specification.

Claims 4 and 28 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Including "organization and comprehensiveness" is not sufficiently described in the claim or specification.

Claim 16 recites the limitation "TLD" in line 1. There is insufficient antecedent basis for this limitation in the claim.

Claim 17 recites the limitation "TLD" in line 1. There is insufficient antecedent basis for this limitation in the claim.

The term "cutting edge technology" in claim 18 is a relative term which renders the claim indefinite. The term "cutting edge technology" is not defined by the claim, the specification does not provide a standard for ascertaining the requisite degree, and one of ordinary skill in the art would not be reasonably appraised of the scope of the invention.

Claim 21 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The term "more than simply geographic" does not sufficiently define what is being claimed.

Claim 24 recites the limitation "TLD" in line 1. There is insufficient antecedent basis for this limitation in the claim.

Claim 25 recites the limitation "TLD" in line 1. There is insufficient antecedent basis for this limitation in the claim.

The term "cutting edge technology" in claim 26 is a relative term which renders the claim indefinite. The term "cutting edge technology" is not defined by the claim, the specification does not provide a standard for ascertaining the requisite degree, and one of ordinary skill in the art would not be reasonably appraised of the scope of the invention.

Claim 36 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant

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regards as the invention. The term "more than simply geographic" does not sufficiently define what is being claimed.

Claims 24-36 each recite the limitation "The system" in line 1, respectively.

There is insufficient antecedent basis for this limitation in the claim.

***Claim Rejections - 35 USC § 103***

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

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6. Claims 1-5 are rejected under 35 U.S.C. 103(a) as being obvious over Pricewatch (www.pricewatch.com, webpages from 1/28/2003) in view of Yahoo (www.yahoo.com, webpages from 12/09/2002).

As per claim 1, Pricewatch teaches

An improved Internet Directory System, comprising: (page 1)

the plurality of CDWs each providing at least a lower level directory referencing websites (WSs) relating to a category; (page 2)

the CDWs being identified as Category Directory Websites participating in the System by at least a mark or a URL portion; (page 3)

and a business model imposed on at least the CDWs. (pages 4-5)

Pricewatch does not explicitly indicate "at least one upper-level Directory Provider (DP), providing a directory of at least upper-level fields and/or super-categories and categories, and referencing a plurality of independently owned (from each other and from the Directory Provider) for-profit Category Directory Websites (CDWs)".

However, Yahoo discloses "at least one upper-level Directory Provider (DP), providing a directory of at least upper-level fields and/or super-categories and categories, and referencing a plurality of independently owned (from each other and from the Directory Provider) for-profit Category Directory Websites (CDWs)" (page 1).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine Pricewatch and Yahoo because using the steps of "at least one upper-level Directory Provider (DP), providing a directory of at least upper-



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level fields and/or super-categories and categories, and referencing a plurality of independently owned (from each other and from the Directory Provider) for-profit Category Directory Websites (CDWs)” would have given those skilled in the art the tools to improve the invention by combining two well-known business concepts on two well-known internet sites into one. This gives the user the advantage of having more and better choices as a consumer.

As per claim 2, Pricewatch teaches  
the business model includes standards of operation imposed on the plurality of CDWs by the System. (page 5)

As per claim 3, Pricewatch teaches  
a standard of operation includes professional management. (page 5)

As per claim 4, Pricewatch teaches  
a standard of operation includes at least one of organization and comprehensiveness. (pages 1-3)

As per claim 5, Pricewatch teaches  
a standard of operation includes up-to-dateness. (page 4)

As per claim 6, Pricewatch teaches

a standard of operation, imposed on at least a subset of CDWs, includes a CDW offering users at least one of an option to move to a secure site to negotiate a purchase and an organization of pertinent comparative data on a subject within the category.  
(page 3 and 5)

As per claim 7, Pricewatch teaches  
the business model includes charging at least some WSs for being referenced.  
(page 5)

As per claim 8, Pricewatch teaches  
the business model includes at least some WSs being charged for at least one service offered by the System. (page 5)

As per claim 9, Pricewatch teaches  
the business model includes a participating CDW providing advertising space on its site. (page 3)

As per claim 10, Pricewatch teaches  
the business model includes a CDW promoting, by advertising, at least one of its category and referenced websites. (page 3)

As per claim 11, Pricewatch teaches

the business model includes at least one advertising/promotion firm that provides advertising/promotion for a category and/or a CDW site substantially in return for advertising space on a CDW site. (page 3)

As per claim 13, Pricewatch teaches  
the business model includes substantially funding operation of a CDW by payments from WSs. (page 4-5)

As per claim 14, Pricewatch teaches  
the business model includes selection of categories for CDWs large enough to support a website and small enough to be managed according to the business plan.  
(page 1-2)

As per claim 15,  
Pricewatch does not explicitly indicate “the business model includes contracting by at least one DP to secure a comprehensive listing of CDWs.”

However, Yahoo discloses “the business model includes contracting by at least one DP to secure a comprehensive listing of CDWs.” (page 1)

It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine Pricewatch and Yahoo because using the steps of “the business model includes contracting by at least one DP to secure a comprehensive listing of CDWs” would have given those skilled in the art the tools to improve the

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invention by combining two well-known business concepts on two well-known internet sites into one. This gives the user the advantage of having more and better choices as a consumer.

As per claim 16, Pricewatch teaches  
the URL portion comprises a TLD. (page 3)

As per claim 17, Pricewatch teaches  
the URL portion comprises a TLD unique to CDWs and DPs in the system. (page  
3)

As per claim 18, Pricewatch teaches  
at least one cutting edge technology cost effectively offered to appropriate  
referenced WSS. (page 3)

As per claim 19,  
Pricewatch does not explicitly indicate "the plurality includes hundreds."  
Yahoo discloses "the plurality" except for "the plurality includes hundreds". It  
would have been obvious to one having ordinary skill in the art at the time the invention  
was made to expand the plurality to include hundreds, since it has been held that the  
mere duplication of the essential working parts of a device involves only routine skill in  
the art (*St. Regis Paper Co. V. Bemis Co.*, 193 USPQ 8).

As per claim 20,

Pricewatch does not explicitly indicate "the Directory Provider comprises an ISP or Search Engine."

However, Yahoo teaches "the Directory Provider comprises an ISP or Search Engine." (page 1)

It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine Pricewatch and Yahoo because using the steps of "the Directory Provider comprises an ISP or Search Engine" would have given those skilled in the art the tools to improve the invention by combining two well-known business concepts on two well-known internet sites into one. This gives the user the advantage of having more and better choices as a consumer.

As per claim 21, Pricewatch teaches

1) the category and 2) at least one field and/or super-category are both more than simply geographic. (page 3)

As per claim 22, Pricewatch teaches

A method for providing an Internet Directory System, comprising: (page 1)  
organizing an independent for-profit directory website to reference websites within a category; (page 3)

adopting a URL portion or a mark identifying said directory website as a participating Category Directory Website; (page 3)

and abiding by a System business model imposed on said Category Directory Websites. (pages 3-4)

Pricewatch does not explicitly indicate "participating in an Internet Directory System by said directory website by contracting to be referenced as one of a plurality of Category Directory Websites (CDW) on at least one independent upper-level Directory Provider's (DP) upper-level directory of at least fields and/or super-categories and categories, the upper-level directory referencing the CDWs".

However, Yahoo discloses "participating in an Internet Directory System by said directory website by contracting to be referenced as one of a plurality of Category Directory Websites (CDW) on at least one independent upper-level Directory Provider's (DP) upper-level directory of at least fields and/or super-categories and categories, the upper-level directory referencing the CDWs" (page 1).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine Pricewatch and Yahoo because using the steps of "participating in an Internet Directory System by said directory website by contracting to be referenced as one of a plurality of Category Directory Websites (CDW) on at least one independent upper-level Directory Provider's (DP) upper-level directory of at least fields and/or super-categories and categories, the upper-level directory referencing the CDWs" would have given those skilled in the art the tools to improve the invention by

combining two well-known business concepts on two well-known internet sites into one. This gives the user the advantage of having more and better choices as a consumer.

As per claims 23-36,

These claims are respectively rejected on grounds corresponding to the arguments given above for rejected claims 2,16-18,3-5,9-10,20,11,6-7,21 and are similarly rejected.

Claim 12 is rejected under 35 U.S.C. 103(a) as being unpatentable over Pricewatch and Yahoo, and further in view of Morimoto (Publication Number 2002/0013774).

As per claim 12,

Pricewatch as modified with Yahoo do not explicitly indicate “the business model includes offering webpage enhancement services at a volume discount.”

However, Morimoto discloses “the business model includes offering webpage enhancement services at a volume discount” (paragraph [0008]).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine Pricewatch, Yahoo, and Morimoto because using the steps of “the business model includes offering webpage enhancement services at a volume discount” would have given those skilled in the art the tools to improve the

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invention by allowing economies of scale to determine prices. This gives the user the advantage of being able to get better prices if willing to spend more money.

### ***Conclusion***

7. The prior art made of record, listed on form PTO-892, and not relied upon is considered pertinent to applicant's disclosure.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jay A. Morrison whose telephone number is (571) 272-7112. The examiner can normally be reached on M-F 8-4:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Tim Vo can be reached on (571) 272-3642. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.



Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



**TIM VO**  
**SUPERVISORY PATENT EXAMINER**  
**TECHNOLOGY CENTER 2100**

Jay Morrison  
TC2100

Tim Vo  
TC2100